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**TS**

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/379,646 08/23/99 LILENFELD

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EXAMINER

WM02/0522

NGUYEN, J

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ART UNIT

PAPER NUMBER

2673

DATE MAILED:

05/22/01

**3**

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/379,646 ✓

Applicant(s)

LILENFELD, DAVID M.

Examiner

Jimmy H. Nguyen

Art Unit

2673 ✓

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: line 2, "a." should be changed to --a--. Appropriate correction is required.
2. Claim 4 is objected to because of the following informalities: line 2, "button" should be changed to --keys are comprised of-- to be consistent with claim 1. Appropriate correction is required.
3. Claim 11 is objected to because of the following informalities: line 2, "bottom" should be changed to --bottom;--. Appropriate correction is required.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, "electrical circuit" in claim 1, "grooves" in claim 6 and "scroll wheel" in claim 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "about" in claim 1 is a relative term which renders the claim indefinite. The term "about" is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification only discloses that the ball 16 is slightly exposed on the left side of the body 11, page 13, lines 1-2. It is noted that Examiner could not find the word "corner" in the specification.

In order to further consider these claims, as best understood, Examiner ignores "about" in claim 1.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Koh et al. (USPN: 5,122,654).

As per claim above, the claimed invention reads on Koh et al.: Koh et al. discloses an ergonomic housing for an electronic input device (a trackball 10, fig. 1) comprising a flat surface (a lower housing 30) and a body, as claimed (col. 3, lines 18-22). The elements in the claim are read in the reference.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koh et al. in view of Harding et al. (USPN: 6,184,869).

As per claims 1-5 and 7, Koh et al. discloses a trackball (10) (fig. 1) corresponding to the claimed cursor control device and comprising a housing with a flat surface (a lower housing 30) and an ergonomics shape (col. 3, lines 18-22); a roller ball (40); three keys (buttons 50a, 50b, 50c) obviously including an enter key and a drag key; electrical circuit (figures 3 and 5); and a communicator which includes a cord, as the claimed electrical cable, and a connector (60) (col. 2, lines 65-68). Koh further teaches the ball being located to the left of the device such that the user's thumb rests on the ball and the user's middle finger rests on the button (fig. 1, col. 3, lines 1-17). In other words, Koh discloses the claimed device except for the roller ball being located at a front corner of the housing.

However, Harding et al. discloses a related cursor control device (10) including a roller ball (50) being located at a front corner of the housing (fig. 1, col. 4, lines 56-57).

Furthermore, it would have been an obvious matter of design choice to relocate the ball of Koh et al., since a such modification would have involved a mere change in the location of a component. A change in location is generally recognized as being within the level of ordinary skill in the art **In re Japikse, 86 USPQ 70 (CCPA 1950)** and as being taught by Harding et al., since the operation of the device would not thereby be modified.

Therefore, these claims above are rejected for the reason as set forth above.

In regard to claims 8 and 9 as applied to claim 1 above, Harding et al. further teaches the cursor control device comprising a communicator which may be one of electrical cable (20) (fig.

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1), or radio frequency transmission or infrared transmission (col. 5, lines 7-11). Accordingly, Koh in view of Harding et al. discloses the claimed device, and these claims are therefore rejected for the reason as set forth above.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koh et al. in view of Harding et al. and further in view of Pejic et al. (USPN: 5,956,018).

In regard to claim 6 as applied to claim 1 above, Koh et al. discloses the claimed device except for the grooves.

However, Pejic et al. teaches a related ergonomic device comprising a plurality of finger indentations (18), as the claimed grooves, to receive and cradle the fingers (fig. 1A, col. 4, lines 26-29) in order to provide a user a comfortable control position (col. 2, lines 60-67).

It would have been obvious to a person of ordinary skill in the art to utilize the grooves of Pejic et al. in the device of Koh et al. in view of Harding et al. because this would provide a user a comfortable control position (col. 2, lines 60-67).

Therefore, it would have been obvious to combine Pejic et al. and Harding et al. with Koh et al. to obtain the invention as specified in claim above.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koh et al. in view of Harding et al. and further in view of Adams et al. (USPN: 6,031,518).

In regard to claim 10 as applied to claim 1 above, Koh et al. in view of Harding et al. discloses the claimed device except for the scroll wheel.

However, Adams et al. teaches a related ergonomic device (fig. 1) comprising a scroll wheel (34) for scrolling the windows on the computer screen up and down as known by one

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skilled in the art (col. 1, lines 39-47). Furthermore, a scroll wheel disposed between the enter key and the drag key, for permitting the up and down scrolling of windows is well-known to one skilled in the art (see specification, page 17, lines 21-22).

It would have been within the level skill in the art to provide a scroll wheel of Adams et al. disposed between the enter key and the drag key in the device of Koh et al. in view of Harding et al. because this would allow a user to scroll the windows on the computer screen up and down, as known by one skilled in the art. This claim is therefore rejected for the reason as set forth above.


### *Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

JHN  
May 17, 2001

  
BIPIN SHALWALA  
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